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(1)

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/711,961	09/06/96	BRANSTROM	A 003/030/SAP

MCMR-JA (JOHN MORAN)
US ARMY MEDICAL RESEARCH
AND MATERIEL COMMAND
FORT DETRICK
FREDERICK MD 21702-5012

HM12/0114

EXAMINER	
RAILEY, J	
ART UNIT	PAPER NUMBER
1636	16

DATE MAILED:

01/14/99

Please find below a communication from the EXAMINER in charge of this application
Commissioner of Patents

Office Action Summary

Application No.

08/711,961

Applicant(s)

Branstrom et al.

Examiner

J. Bailey

Group Art Unit

1636

☒ Responsive to communication(s) filed on 26 Oct 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27, 34-43, and 45-55 is/are pending in the application.

Of the above, claim(s) 1-27 and 34-43 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 45-55 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claims 1-27 and 34-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 6.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,824,538. (The previous rejection was a provisional rejection based upon Application No. 08/523,855, which has now issued as U.S. Patent No. 5,824,538.) Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims methods for delivery of exogenous DNA capable of being expressed in an animal cell, while the claims in the patent are drawn to similar methods for mammalian cells, as well as the delivery vehicles for such methods. The claims in the instant application are obvious over the claims in the patent.

This rejection is maintained for reasons as set forth in the previous office action, paper No. 12, mailed 24 April 1998. Applicant's response received 26 October 1998, paper No. 15, states that, upon indication from the Examiner that the application is otherwise in condition for allowance, Applicant's will file a terminal disclaimer. In an effort to provide rapid customer service, the examiner made at least two more attempts to secure a terminal disclaimer in the instant application, after receiving applicant's response of 24 April 1998. However, applicant's representative, Ann Hobbs, has indicated her difficulty in obtaining such a disclaimer in a timely manner from her client. Consequently, the grounds of the rejection remain of record.

The examiner appreciates the clarification of the record in regard to the primer sequences found in Figure 1, as well as the correction of the depository address for the ATCC.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date

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Art Unit 1636

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of this final action.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Art Unit 1636 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number for Art Unit 1636 is (703) 308-4242 or 305-3014.

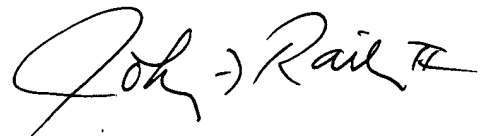
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. F. Railey, whose telephone number is (703) 308-0281. The examiner can normally be reached on Monday-Thursday, and alternate Fridays, from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached at (703) 308-4003. The fax phone number for informal transmissions to the examiner is (703) 305-7939.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

13 January 1999

**JOHNNY F. RAILEY II, PH.D.
PRIMARY EXAMINER
TECHNOLOGY CENTER 1600**

A handwritten signature in cursive script, reading "John F. Railey II".